

DISCUSSION OF THE AMENDMENT

Claims 1-28 are active in the present application. Claims 2 and 3 are presently withdrawn from active prosecution. Claims 23-28 are new claims. Support for the new claims is found in the examples.

No new matter is added.

REMARKS

Applicants thank the Examiner for withdrawing the rejections under 35 U.S.C. § 112 and 103 as set forth in the Office Action of January 2, 2008. Applicants further thank the Examiner for the helpful and courteous discussion of October 8, 2008. During the discussion Applicants' U.S. representative pointed out that the art relied on by the Office in support of the rejections was directed to different compositions not encompassed by the present claims.

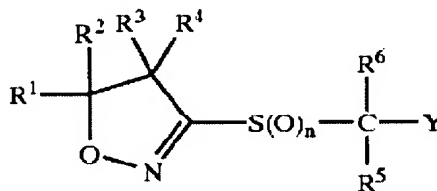
The Office rejected Claim 1 for obviousness-type double patenting over Claim 8 of U.S. Patent No. 7,238,689 ("the '689 patent") in combination with Sievernich (US 6,534,444). The Office acknowledges that the compositions of the '689 patent are different from the presently claimed compositions insofar as the '689 compositions do not require the presence of a second herbicidal active compound. The Office relies on Sievernich as evidence that it is known to combine herbicides to increase the herbicidal efficacy of the resultant composition. The Office states:

It is known in the art that combining herbicides increase the efficacy of a herbicide such that the maximum level control or growth regulation for a given application rate of a herbicide is increased, or alternately, the application rate of a herbicide giving optimum control or growth regulation can be reduced. From this extensive overlap of subject matter, one of ordinary skill in the art would recognize that the same product is produced in the patent.

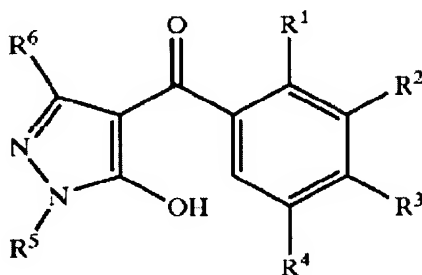
Last two sentences of the first full paragraph of page 3 of the August 7, 2008 Office Action.

It appears that the Office relies on Sievernich as evidence that generic mixtures of herbicides always result in increased efficacy in comparison to the efficacy of the underlying herbicides individually. Applicants submit that Sievernich demonstrates a synergistic effect only for the benzoyl compound-containing composition described in Sievernich (see the Abstract of Sievernich). The active ingredient of the Sievernich patent (i.e., the benzoyl compound of formula I) is different from the isoxazoline derivative of formula (I) recited in

present Claim 1. For convenience, the structure of the benzoyl compound of Siervernich and the isoxazoline derivative recited in the presented claims are shown below:



Isoxazoline of the present claims



Benzoyl derivatized compound of Siervernich

At best Siervernich discloses that synergistic herbicidal properties are obtained with herbicides that contain the particular benzoyl compound of formula I. Siervernich does not disclose or suggest that similar or equivalent synergistic herbicidal effects occurs generically, i.e., for all types of herbicides.

The Office's reliance on Siervernich as support for the assertion that the subject matter of the present Claim 1 is obvious over the subject matter of Claim 18 of the '689 patent is not supportable in view of the Office's failure to provide any reasonable technical or legal basis by which one of ordinary skill in the art could conclude that any synergistic behavior observed for the benzoyl compound-containing compounds of Siervernich would necessarily, i.e., inherently, occur for the isoxazoline derivatives recited in the present claims.

In fact, Siervernich demonstrates “synergistic” effects only under very limited conditions. For example, Siervernich exemplifies herbicidal compositions that function by application directly to a plant surface (i.e., in a post-emergence treatment regimen) such as when the herbicidal compositions are applied onto the foliage of certain plants (see the examples in columns 33-56 of Siervernich).

The Office’s assertion that Siervernich discloses that a generic herbicidal effect may be obtained by combining different compounds in an herbicidal composition is not correct. Siervernich only discloses such activity for certain benzoyl-containing compositions when applied by foliar treatment.

In contrast, Applicants have shown that the herbicidal composition of the present claims has improved performance when used as a soil treatment (see pages 146-147 of the present specification). Table 18 on page 147 of the present specification demonstrates that using a combination of the isoxazoline derivative of Group A and a Group B compound provides an herbicidal effect that is greater than the cumulative herbicidal effect of the Group A and B components individually.

At best, Siervernich discloses a synergistic effect obtained by treating the foliage of undesired plants. Siervernich does not provide any evidence that a synergistic herbicidal effect may be obtained by applying the Siervernich composition to soil instead of to foliage.

Applicants thus submit that those of ordinary skill in the art would have no reason to believe that any synergistic herbicidal effect shown in Siervernich would likewise occur for the herbicidal compositions recited in the present claims.

Applicants thus submit that the rejection of Claim 1 for obviousness-type double patenting over the ‘689 patent and Siervernich should be withdrawn.

Applicants draw the Office’s attention to new dependent Claims 23-28. The new dependent claims recite aspects of the improved herbicidal effects obtained by the

composition of the present claims and/or conditions under which such improvements are obtained. Applicants submit the new dependent claims recite the advantages provided by the claimed compositions and are thus are further patentable over the art cited by the Examiner.

The Office also rejected the claims for obviousness-type double patenting over co-pending U.S. Application No. 11/948,542 (“the ‘542 application”). Applicants note that the obviousness-type double patenting rejection over the ‘542 application is a provisional rejection. Applicants submit that after the Office has withdrawn the obvious-type double patenting rejection over the ‘689 patent, the obviousness-type double patenting rejection over the ‘542 application will be the only remaining rejection in the present case. The present case is the senior case. Applicants submit that it is appropriate for the Office to withdraw the obviousness-type double patenting rejection from the present application and enter such rejection in the ‘542 application.

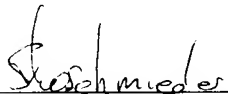
REQUEST FOR REJOINDER

Applicants submit that the arguments above are sufficient for demonstrating the patentability of the present claims. Upon determining that the subject matter of Claim 1 is allowable, Applicants respectfully request rejoinder and allowance of Claims 2 and 3 which depend from Claim 1 and are presently withdrawn from prosecution.

For the reasons discussed above, Applicants request withdrawal of the rejections in the allowance of all now-pending claims.

Respectfully submitted,

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